

## **REMARKS**

Favorable reconsideration and allowance of this application are requested.

### **1. Summary of Amendments**

By way of the amendment instructions above, claims 1-12 have been canceled and claim 13 has been amended so as to be in independent format. Claims 14-19 have been newly presented and are based on prior claims 3, 5 and 7-10, respectively.

Accordingly, following entry of this amendment, claims 13-19 will remain pending herein for consideration. Favorable reconsideration and allowance of all pending claims is solicited.

### **2. Response to Issues Raised in Official Action**

The Examiner asserts that prior claims 1, 5 and 7-13 are obvious under 35 USC §103(a) over US 2002/0183073 (Uno et al.) and US 2003/0100381 (Joachimi et al.). In addition, the Examiner asserts that claim 3 is obvious over Uno et al., Joachimi et al and US 2002/0190408 (Houston et al.) Applicants respectfully suggest that the applied publications of record are inappropriate against claims 13-19 pending herein for consideration.

At the outset, applicants note that Uno et al, Joachimi et al and Houston et al are the same publications applied in the prior Official Action. Accordingly, in order to prevent overburdening of the Official Record, applicants hereby incorporate by reference herein the comments made in the Amendment After Final Rejection dated December 11, 2008.

Applicants emphasize at this juncture, however, that the applied references fail to disclose a laser welding process using a combination of the specific polybutylene terephthalate-series copolymer (PBT-series copolymer), the specific elastomer, the

polycarbonate-series resin and the specific plasticizer in the specific proportions as claimed herein.

The Examiner accepts that Uno et al. is silent on laser welding procedures. Accordingly, an ordinarily skilled person could not possibly be motivated toward laser welding processes generally by Uno et al. More specifically, since Uno et al. fails to disclose laser welding processes, an ordinarily skilled person would not be motivated to combine Uno et al. with Joachimi et al. in developing a specific laser welding process. Further, even assuming that Uno et al. and Joachimi et al might possibly be combined, a laser welding process using the specific combination could not have been predicted therefrom.

Thus, the advantages of the present invention would therefore never have been derived from the cited references.

Withdrawal of all rejections of record is therefore in order.

### **3. Response to Double Patenting Rejection**

Claims 1, 7-8 and 10-13 also attracted a non-statutory obviousness-type double patenting rejection based on claims 1-14 of USP 7,396,428 ("the '428 patent"). In response, applicant is enclosing herewith a Terminal Disclaimer which disclaims that portion of any patent issuing hereon which may extend beyond the expiration date of the '428 patent. Additionally, the Terminal Disclaimer filed herewith also includes a provision that the patent issued hereon shall be enforceable only for and during such period that legal title thereto is the same as the legal title to the '428 patent.

While applicant does not concur with the Examiner's position that the improvement sought to be patented herein is merely a matter of obvious choice or design as compared to the invention claimed in the '428 patent, applicant wishes to point out that, in situations such as this, the issue is not one of "obviousness", but rather

**SAKATA et al**  
**Serial No. 10/574,574**  
June 15, 2009

one of "identity of invention." *In re Vogel*, 164 USPQ 619 (CCPA 1970), *In re Kaplan*, 229 USPQ 678 (Fed. Cir. 1986). The Court in *Vogel* set forth the test for identity of invention as whether the claims of one case could be literally infringed without literally infringing the claims of the other. It is quite apparent that one of the claims of one of the '428 patent and the present application could be infringed literally without infringing literally the claims of the other. Hence, there is no "identity of invention" so that the Terminal disclaimer enclosed herewith should, in any event, resolve the asserted issue of "double patenting".

#### **4. Conclusion**

All issues raised in the Official Action dated February 20, 2009 appear to have been addressed by way of the present amendment. Therefore, early receipt of the Official Allowance Notice is awaited.

#### **5. Fee Authorization**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:                     /Bryan H. Davidson/                      
Bryan H. Davidson  
Reg. No. 30,251

BHD:dlb  
901 North Glebe Road, 11<sup>th</sup> Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100